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Juha Syri

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EXAMINER

SHAHEED, KHALID W

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

06/08/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,050	<b>Applicant(s)</b> SYRI ET AL.	
	<b>Examiner</b> KHALID SHAHEED	<b>Art Unit</b> 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3-11-10.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

*Applicant's arguments filed 3/11/2010 have been fully considered but they are not persuasive.*

*The remarks filed indicate that the suggested Prior Art Thro (6,147,977) does not at the mobile station as claimed by the applicant's invention. In supporting this the applicant provides that one having ordinary skill in the art would have recognized: (a) the importance level of a message is determined at the mobile station; and (b) the basis for determination is user preference.*

*The examiner respectfully disagrees with applicants explanation of the prior art in regards to the claimed invention. Firstly, the applicant sights [0046]-[0047] of the instant application. Both paragraphs literally point to "user control", "user's effort for prioritization of the e-mail messages". The applicant has determined this concept to be (a) the importance level of a message is determined at the mobile station. If this is the basis of such a determination then it is clear that Thro is prior art. Therefore, Thro clearly discloses the same user controlled prioritization (see "this technique allows the user to establish some priority" - col. 2 lines 21-24; user...establishes a priority matrix – col. 3, lines 50-53; "user rule set for interpreting ...priority levels" col. 3, lines 64-67). As a result it would be recognized by one having ordinary skill in the art: the features of aforementioned points (a) and (b).*

*Additionally, the applicant denies that Horvitz has reference to any algorithm for any kind of statistical analysis. The examiner fully disagrees with this finding. Horvitz clearly discloses an algorithm in [0025] for analysis and of linguistic contents [0041].*

### **Claim Status**

1. Claims 1 – 34 are pending.

### ***Allowable Subject Matter***

2. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 33 & 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer-readable storage medium has not been adequately defined as a transient or non-transient medium.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 33 & 34 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See “computer-readable storage medium”

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 10-13, 16-17, 26-28, 30-34 are rejected under 35 U.S.C. 102(B) as anticipated by Thro (US 6,147,977).

**In regards to claims 1 & 33**, Thro discloses a method comprising and computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processor causes an apparatus to at least perform the following:

(causing at least in part) receiving an electronic mail message at the mobile station ("receives", abstract)

indicating the electronic mail message by a level as to a preference of the electronic mail message for a user of the mobile station (abstract),

(causing, at least in part) transferring data information indicating the preference to a computing system operating a mail agent (see 52 in fig. 2, and abstract), and

(causing at least in part) processing data information indicating the preference for resulting in an order of preference ("priority") for electronic mail messages for the user (abstract) .

**In regards to 16**, Thro discloses comprising:

receiving an electronic mail message at a computing system operating a mail agent (see fig. 3),

processing ("process", abstract) the electronic mail message for resulting in an order of preference for electronic mail messages for a user of the mobile station (see "priority", abstract and fig. 3), and

transferring a list indicating the order of preference (invention is clearly capable of this functionality – see 68 & 82 in fig. 2) for the electronic mail messages for the user to the mobile station (abstract).

**In regards to 17**, Thro discloses a system for obtaining an electronic mail service for a mobile station, the system comprising:

a mobile station for receiving an electronic mail message and for indicating the electronic mail message by a level as to a preference (see "level" in fig. 2 and col. 5, lines 50-54) of the electronic mail message for a user of the mobile station,

a network for transferring data information ("communication network", col. 3, line 36 and fig. 1) indicating the preference (abstract and see priority levels indicated in fig. 2) to a computing system operating a mail agent (see fig. 3), and

the computing system operating the mail agent for processing (abstract) the data information indicating the preference for resulting in an order of preference for electronic mail messages for the user (see 68 and 82 in fig. 2).

**In regards to claims 31 & 34,** Thro discloses a system and computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processor causes an apparatus to at least perform the following:

Causing at least in part and/or providing an electronic mail service for a mobile station, the system comprising: a computing system operating a mail agent for receiving an electronic mail message (abstract), and for processing the electronic mail message for resulting in an order of preference for electronic mail messages for a user of the mobile station (abstract), and a network for transferring (“communication network”, col. 3, line 36 and fig. 1) a list indicating the order of preference for the electronic mail messages for the user to the mobile station (invention is clearly capable of this functionality – see 68 & 82 in fig. 2).

**In regards to claim 32,** Thro discloses a mobile station for providing a user an electronic mail service, the mobile station comprising:



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an output for presenting an electronic mail message at the mobile station (see “output”, col. 7, lines 27-29) and see (col. 9, lines 30-34),

means for indicating the electronic mail message by a level as to a preference of the electronic mail message for a user of the mobile station (see fig. 2, 68 and 82), and

means for transferring data (abstract, fig.2 and 3) information indicating the preference to a computing system operating a mail agent (abstract and see features of fig. 3), wherein the mail agent is for processing data information indicating the preference for resulting in an order of preference for electronic mail messages for the user (abstract, see “priority matrix” in fig. 3, furthermore see 68,82 in fig. 2 as it relates to this priority matrix).

**In regards to claims 10 & 26**, Thro discloses a method according to claim 1, wherein the preference for electronic mail message comprises at least one of electronic mail message having a relevance for the user, and electronic mail message not having a particular relevance for the user (“priority”, abstract and see 68,82 in fig. 2).

**In regards to claim 11**, Thro discloses a method according to claim 1, wherein the step of indicating comprises entering an option (“inputs”) depicting the preference by the mobile station for the electronic mail message (col. 7, lines 35-39).

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**In regards to claims 12 & 27**, a method according to claim 1, wherein the order of preference for electronic mail messages comprises a list, wherein the most preferred electronic mail messages are among the firsts in the list, and as the list proceeds, the less relevancy the electronic mail messages for the user establish ("priority", abstract and see 68,82 in fig. 2).

**In regards to claims 13 & 28**, Thro discloses wherein at least a part of the electronic mail message is contained in a message viable in a mobile environment ("mobile radios", col. 3, lines 40-45).

**In regards to claim 30**, Thro discloses a system according to claim 17, wherein the network comprises a mobile network and a fixed network (see fig. 1).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2-9, &18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thro in view of Horvitz (US 2004/0172457 A1).

**In regards to claims 2-9 & 18-25** (wherein claim 2 depends form claim 1 and 18 depends on claim 17), Thro discloses the method of claims 1 & 17.

Thro does not specifically disclose one algorithm based on a statistical analysis of linguistic contents as covered by claim 2 and depending on claims 3-9, claim 17 and depending on claims 18-25.

Horvitz discloses a method according to claim 1, wherein the step of processing is based on an appliance of at least one algorithm based on a statistical analysis of linguistic contents of the electronic mail message (abstract, [0025]).

wherein the step of processing further comprises applying a user profile containing information about the preference of the user for certain electronic mail messages [0017].

wherein the linguistic contents comprises Terms (fig. 2 and abstract, [0026]).

wherein the terms comprises predetermined character strings [0026].

wherein the step of processing further comprises a selection of a relevant word ([0041]-[0042] and [0082]).

wherein the selection of the relevant word comprises dividing the electronic mail messages into two groups: interesting ("high priority"), and not having a particular relevancy ("low priority") ([0015] and see this in respect to "threshold" in [0008]).

wherein the step of processing further comprises an appliance of a priority model, wherein the priority model contains beforehand established pattern for the user about the preference of the user for certain electronic mail messages (abstract, [0015]).

wherein the step of processing further comprises an appliance of a message priority [0015].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the prior art features as disclosed by Horvitz with those of Thro. Doing so would provide a added accuracy in providing error free email priority processing.

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12. Claims 14 & 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thro in view of Tarnanen et al (US 6,834,196).

**In regards to claims 14 & 29**, Thro discloses, a method according to claim 13.

Thro does not specifically discloses the message comprises at least one of a data packet for a transfer in a packet based mobile environment, a SMS for transfer in a GSM environment, USSD for transfer in a GSM environment, R-data for transfer in a TDMA environment.

Tarnanen specifically discloses the message comprises at least one of a data packet for a transfer in a packet based mobile environment, a SMS for transfer in a GSM environment, USSD for transfer in a GSM environment, R-data for transfer in a TDMA environment (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the prior art features as disclosed by Tarnanen with those of Thro. The motivation for doing so would be to improve compatibility and transparency between email and mobile messaging systems.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Horvitz (US 6,714,967)** integration of a computer-based message priority system with mobile electronic devices.

**Gruen et al. (US 2006/0245388 A1)** discloses a method and apparatus for electronic mail interaction with grouped message types.

**Martin (US 6,606,373 B1)** discloses a controller for use with communications systems for generating a condensed text message index.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHALID SHAHEED whose telephone number is

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(571)270-5813. The examiner can normally be reached on Monday-Friday 8am-5pm; EST; ALT Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Paul Harper can be reached on 571-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617

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